

REMARKS

Claims 1-7 and 15-20 were rejected in the parent application. To expedite the prosecution of the parent application, however, those claims were canceled (placing claims 7-14 in condition for allowance). Applicants continue to present claims 1-7 and 15-20 herein. For at least the reasons set forth below, Applicants respectfully submit that the rejections (in the parent application) of these claims should be withdrawn.

Independent Claims 1 and 15

The Office Action of the parent application rejected independent claims 1 and 15 under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent 6,134,565 to Hommersom, et al in view of U.S. Patent 6,295,388, to Stokes et al. Applicants disagree and respectfully request that this rejection be overturned.

Independent claim 1 recites:

1. A system for controlling document region analysis, comprising:
an interim analyzer configured to perform an interim document analysis to identify a number of interim regions on a digital document at a first pixels-per-inch (PPI); and
a complete analyzer configured to *perform a complete analysis on at least one of the interim regions at a second PPI*, thereby generating at least one complete region therefrom.

(*Emphasis added.*) Applicants respectfully submit that claim 1 patently defines over the cited art for at least the reason that the cited art fails to disclose or otherwise teach the features emphasized above.

In rejecting claim 1, the Office Action has misapplied teachings of Hommersom and Stokes. For example, the Office Action has cited the entire teachings of FIG. 1, FIG. 3A – elements S1-S4, col. 3 lines 51 and 52, and col. 4 lines 12-18 and 22-25, as allegedly teaching the claimed “interim analyzer.” Similarly, the Office Action has cited FIG. 3A – element S8 and col. 5 lines 4-8 and 19-24 as allegedly teaching the claimed “complete

analyzer.” This application of Hommersom is fundamentally misplaced. Elements S1-S4 of FIG. 3A disclose: “segmentation into objects,” “filtering of segmentation image,” “positional features determination,” and “segmentation image interpretation.” Simply stated, none of these elements even remotely relate to the interim analyzer, as defined by claim 1. Likewise, element S8 of FIG. 3A discloses “read sequence determination,” which doesn’t remotely relate to the claimed complete analyzer.” Quite candidly, Applicants are at a loss as to understand how or why the Office Action has alleged that these teachings apply to the cited elements defined by claim 1. It appears as if the Office Action has wholly ignored the context of the terms “interim analyzer” and “complete analyzer” as used in the claims and as described in Applicants’ specification (i.e., the Office Action ignored the proper interpretation of the these elements), and assigned these terms an interpretation of its choice.

The cited portions of the Hommersom patent fail to teach the “interim analyzer” element as defined in claim 1. Furthermore, even if the single analysis of Hommersom is interpreted to be an “interim” analysis, then there is a complete failing of Hommersom to disclose a secondary or complete analysis (the cited “read sequence determination” is in no way a complete analyzer). For at least this reason, the rejection of claim 1 is misplaced.

Stokes is equally inapplicable, as it does not supply these missing teachings. In this regard, FIG. 6 of Stokes, which the Office Action relied upon, specifically teaches the performance of a “preview scan” and a (later) “hi-resolution scan.” The Office Action has misapplied teachings of a two-step scanning process with a two-stem analyzing process. In the Applicants’ claimed invention, a single scan is performed to convert a physical (e.g., paper) document into an electronic (e.g., digital) document. The digital document is then analyzed in two steps. A first, interim analysis is performed at a lower resolution, while a second, complete analysis is performed at a higher resolution.

Simply stated, Stokes does not teach such a two-step analysis (but rather a two-step scanning process).

For at least this independent reason, the rejection of claim 1 is misplaced.

As a separate and independent basis for the patentability of claim 1, Applicants respectfully traverse the combination of the Stokes patent with Hommersom patent. It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. *W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc.*, 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) *In re Dow Chemical Company*, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicants note that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to create a document analysis method and apparatus as claimed by the Applicants.

In the present situation, however, the Office Action has merely concluded that the combination of Hommersom and Stokes would have been obvious *“because they are analogous in analyzing a document.”* The mere fact that references exist in a similar or analogous art is insufficient to supply a proper motivation or suggestion for their combination.

Indeed, this position is completely counter to well-established Federal Circuit case law. In this regard, Applicants refers to *Continental Can Co., USA, Inc. v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991). In that case, the claimed invention was directed to a ribbed bottom structure for reinforcing a plastic container. The patent in suit claimed that each container rib was hollow. The prior art consisted of several patents directed to ribbed configurations comprising the support structure of plastic container bottoms. The primary reference was a Marcus patent, which disclosed a plastic container having a ribbed bottom, wherein the ribs were solid. A Pentaloid patent was a secondary reference which, when inverted, closely resembled the claimed invention. The Federal Circuit, however, quickly dismissed this simple modification as constituting an obvious change by stating "Although a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside

down." *Continental Can* at 1270.

Several prior art references in the *Continental Can* case disclosed plastic containers having ribbed bottoms, wherein the ribs were hollow. In rejecting the notion that elements from prior art references can be mixed and matched randomly in an effort to render obvious the claimed invention, the Federal Circuit stated that "When prior art references require selective combination ... to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." *Continental Can* at 1271. "The criterion of 35 U.S.C. § 103 is not whether the differences from the prior art are simple enhancements, but whether it would have been obvious to make the claimed structure. *Continental Can* at 1273.

Perhaps more illuminating on this point is the quotation from *Lairam Corp. v. Cambridge Wire Cloth Co.*, 226 USPQ 289, 293 (D. Md. Mag. 1985), where the court stated ``To illustrate this notion, you cannot claim that the existence of a unicorn should be obvious from taking a trip to the zoo and seeing a horse and a white rhinoceros in adjacent cages. It takes a spark of inventiveness to look at a horse and then look at a white rhinoceros and then conceive the idea of a white horse with a horn.''

For at least this additional and independent reason, the rejection of claim 1, in the parent application, is misplaced.

Independent claim 15 is a method claim that recites similar language, for purposes of the relevance or applicability of the cited art. Accordingly, for the same reasons set forth above in connection with claim 1, claim 15 patently defines over the cited art.

Dependent claims 2-7 and 16-20

Dependent claims 2-7 and 16-20 each include all the limitations of claims 1 and 15, respectively, and therefore patently define over the cited art for at least the same reasons as claims 1 and 15.

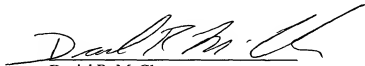
New claims 21-29

New claims 21-29 are added and clearly define over the cited art of record, by defining a system and method for analyzing a physical document. These claims recite limitations not shown or suggested in the cited art.

AUTHORIZATION TO DEBIT ACCOUNT

It is believed that no extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Company's deposit account no. 08-2025.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Daniel R. McClure", is written over a horizontal line.

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